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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/715,294 | 11/17/2000 | Narendra S. Yadav | CL1127 US CIP1 | 5868 |

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E I DU PONT DE NEMOURS AND COMPANY
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WILMINGTON, DE 19805

EXAMINER

MEHTA, ASHWIN D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1638

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/715,294

Applicant(s)

YADAV, NARENDRA S.

Examiner

Ashwin Mehta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-41, 43, 70 and 80-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 82 and 84 is/are allowed.
- 6) ☒ Claim(s) 39-41, 43, 70, 80, 81, 83 and 85 is/are rejected.
- 7) ☒ Claim(s) 42 & 86 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 January 2003 & 03 February 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 18, 2005 has been entered.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The rejection of claims 39-43, 70, and 80-86 under 35 U.S.C. 112, first paragraph is withdrawn upon further consideration.

Claim Objections

4. Claim 42 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. Claims 86 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 82. When two claims in an application are duplicates or else are so close in content that they both

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cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Both claims are directed to a method in which a transgene is conditionally activated in a second generation plant. The structures of the constructs used in the method, and the method steps are the same. Claim 82 indicates, in step 3), that P1 is activated, and in step 4) that P2 is activated, whereas claim 86, in step 3), indicated that P1 is induced. The same steps that lead to activation of P2 in claim 82 is encompassed by claim 86. P2 is a floral specific promoter in both claims. There does not appear to be a difference in scope between these two claims.

6. Claims 39-41, 43, 70, 80, 81, 83, and 85 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Odell et al. "A" (Mol. Gen. Genet., 1990, Vol., 223, pages 369-378) in combination with Lloyd et al. (Mol. Gen. Genet., 1994, Vol. 242, pages 653-657), Applicant's admitted state of the prior art, and Odell et al. "B" (Use of Site-Specific Recombination Systems in Plants, in Homologous Recombination and Gene Silencing in Plants, 1994, pages 219-270, Ed. Paszkowski, J., Publisher: Kluwer, Dordrecht, Germany), for the reasons of record stated in the previous Office actions. Applicant traverses the rejection in the paper filed April 18, 2005. Applicant's arguments have been fully considered but were not found persuasive.

Applicant argues, in reference to the declaration submitted August 12, 2004 under 37 CFR 1.132, signed by Dr. Joan Odell, the interest or disinterest of the party of the party offering evidence cannot be disregarded on this aspect alone, and cite MPEP 716.01(b) in support. Applicants maintain that the declaration of Dr. Odell is some evidence that the combination of multiple SSR systems in plants was unexpected and viewed with skepticism by an expert in the

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art of site-specific recombination (response, paragraph bridging pages 12-13). However, this was not the only reason presented in the previous Office action. The action also indicated that the reference, discussed in the declaration, did not indicate that the words, "quite impressive" referred to effectiveness relative to expectations of no or barely detectable recombination, as alleged in the declaration. In the declaration Dr. Odell indicated that the use of systems involving activation of selection markers to detect recombinase activity in both Odell et al. and Lloyd and Davis shows that the expectation that successful recombination would occur was low (declaration, item 8). However, Lloyd et al. as well as Odell et al. demonstrated the successful use of site specific recombination systems on a substrate as complex as a chromosome in a plant cell in a transgenic plant.

Applicant also argues that the fact that other patents have now been filed exemplifying the use of multiple SSR systems in plants is evidence of commercial success (response, page 13, 1st full paragraph). However, the invention claimed in the patents referred to by Applicant is distinct from the present invention. Further, a patent is not a guarantee or indication of commercial success in the marketplace. Applicant also argues that the fact that there is no reported use of multiple SSRs in plants in the prior art is evidence of the failure of others (response, page 13, 1st full paragraph). However, Applicant has not shown any evidence of actual failure.

7. Claims 82 and 84 are allowed, claims 42 and 86 are objected to, and claims 39-41, 43, 70, 80, 81, 83, and 85 remain rejected.

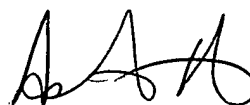
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Contact Information

Any inquiry concerning this or earlier communications from the Examiner should be directed to Ashwin Mehta, whose telephone number is 571-272-0803. The Examiner can normally be reached from 8:00 A.M to 5:30 P.M. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Amy Nelson, can be reached at 571-272-0804. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

June 30, 2005



Ashwin D. Mehta, Ph.D.
Primary Examiner
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